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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/811,432	03/20/2001	Klaus Muller	732/000035	1490

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KEIL & WEINKAUF
1350 CONNECTICUT AVENUE, N.W.
WASHINGTON, DC 20036

EXAMINER

FERGUSON, LAWRENCE D

ART UNIT	PAPER NUMBER
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1774

DATE MAILED: 06/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/811,432

Applicant(s)

MULLER ET AL.

Examiner

Lawrence D Ferguson

Art Unit

1774

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 March 2004.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 5 and 6 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1, 5 and 6 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. This action is in response to the amendment mailed March 25, 2004.

Claim 1 was amended, rendering claims 1 and 5-6, with claims 12-13 withdrawn as a non-elected invention.

Obvious Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1 and 5-6 provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-2, 5, 9, 12, 19 and 20 of copending Application No. 10/260,654 in view of Nicholas et al (U.S. 3,668,034). Both 09/811,432 and 10/260,654 include a layered composite material comprising a substrate (backing) comprising thermoplastic polymer, an intermediate layer composed of thermoplastic polypropylene and is a nonwoven layer, along with a

decorative layer applied to the intermediate layer and a heat cured layer on top of the decorative layer. They both include a total thickness of 1 to 100 mm, with the substrate making up at least 80%. 10/260,654 does not include the decorative layer being composed of chrome. Nicholas teaches a layered material comprising a backing layer formed of thermoplastic material and an intermediate layer with an outer metalized film (abstract) where the layered material has an outer decorative layer (column 1, line 7) and the film is made of chrome (column 1, line 41). 10/260,654 and Nicholas are analogous art because they are both directed to multilayer decorative materials. It would have been obvious to one of ordinary skill in the art to include metal chrome in the decorative layer of 10/260,654 to improve reflectivity, corrosion resistance and abrasion resistance of the composite material.

This is a provisional obviousness-type double patenting rejection.

Claim Rejections – 35 USC § 103(a)

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1 and 5-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nicholas et al (U.S. 3,668,034) in view of Vinod (U.S. 5,965,232).

Nicholas discloses a layered material comprising a backing layer formed of thermoplastic material and an intermediate layer with an outer metalized film (abstract)

where the layered material has an outer decorative layer (column 1, lines 7). Nicholas discloses the metallized film is made of chrome (column 1, line 41) having an intermediate layer formed of thermoplastic material (column 2, lines 3-4).

Nicholas does not disclose a heat cured layer, a non-woven intermediate layer or the substrate made of polypropylene. Vinod teaches a layered composite material comprising a decorative layer, intermediate layer and lower layer coated with a protective coating (column 1, lines 39-41) where the coating is heat cured (column 5, lines 13-14) and the lower and intermediate layers are made of polypropylene (column 7, lines 11-18 and column 7, lines 44-58) and the intermediate layer is made of non-woven thermoplastic material (column 5, line 46 through column 6, line 7). Nicholas and Vinod are analogous art because they are from the same field of layered thermoplastic material. It would have been obvious to one of ordinary skill in the art to include polypropylene in the substrate of Nicholas because Vinod teaches polypropylene to provide the multilayered composite with more protection from outside influences. Additionally it would have been obvious to one of ordinary skill in the art to include a heat cured layer because Vinod teaches the heat curing layer increases the original presentation of the multilayered decorative composite (column 5, lines 10-25) by protecting it from environmental hazards. It would have been obvious to one of ordinary skill in the art for the intermediate layer of Nicholas to be non-woven to increase the durability of the composite material. Although neither reference specifically discloses the total thickness, thickness is an optimizable feature. It would have been obvious to one of ordinary skill in the art to optimize the components because discovering the optimum

or workable range involves only routine skill in the art. The thickness directly affects durability of the composite material. *In re Aller* 105 USPQ 233 and see *In re Boesch*, 617 USPQ 215. In amended claim 1, ‘...a non-woven composed of a polypropylene prepared in presence of a metallocene catalyst’ and ‘...been applied to the decorative layer’ are product by process claim limitations, which are given little patentable weight in product claims. “Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.” *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966.

Response to Arguments

5. Remarks of rejection made under 103(a) as being unpatentable over Nicholas et al (U.S. 3,668,034) in view of Vinod (U.S. 5,965,232) have been considered but are unpersuasive. Applicant argues only Nicholas is used to teach any thermoplastic can be used as the intermediate layer. Examiner respectfully disagrees because Vinod teaches the lower and intermediate layers are made of polypropylene (column 7, lines 11-18 and lines 44-58). Applicant argues a prima facie case of obviousness has been established because the rejection does not disclose the intermediate layer as non-woven. Vinod teaches a layered composite material comprising a decorative layer, intermediate layer

and lower layer coated with a protective coating (column 1, lines 39-41) where the intermediate layer is made of non-woven thermoplastic material (column 5, line 46 through column 6, line 7).

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lawrence Ferguson whose telephone number is 571-

272-1522. The examiner can normally be reached on Monday through Friday 9:00 AM – 5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly, can be reached on 571-272-1526. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Lawrence D. Ferguson
Examiner
Art Unit 1774

CYNTHIA H. KELLY
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700

